

Applicant : Jeffrey H. Michaud, et al.
Serial No. : 09/058,496
Filed : April 10, 1998
Page : 2 of 7

Attorney's Docket No.: 07844-273001 / P247

REMARKS

Claims 1-9, 12, 13, 15, 16, 20-22, 24, 25 and 28-46 are pending in this application. Claims 37 and 44 are objected to by the Examiner, and the balance of the claims are rejected under 35 U.S.C. § 103(a).

Section 103 Rejections

Claims 1-5, 7-9, 12-13, 20-22, 29-30, 35-36 and 42-43

Claims 1-5, 7-9, 12-13, 20-22, 29-30, 35-36 and 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit Imagemap Editing Software, Version 2.3 for Windows 3.1, 1997 by Boutell.com, Inc. URL: <http://www.boutell.com/mapedit>, pp. 1-19 ("Mapedit"), in view of U.S. Patent No. 6,034,689 ("White").

Claim 1 recites a method by which a "hot spot" area is defined in an electronic artwork. According to the method, user input selecting a layer of a multilayer electronic artwork is received. In response to the user input selecting a layer, one or more regions in the selected layer are identified as non-transparent regions in a transparent frame. An area in the selected layer is defined based on a perimeter boundary of the non-transparent regions in the selected layer. An action that defines a function to be activated when the area is selected is assigned to the area, and the area and actions are associated with the selected layer as a property of the selected layer in the electronic artwork.

"receiving from a user an input selecting a layer in an electronic artwork having a plurality of layers"

The above recites the first limitation of claim 1. The primary reference relied on by the Examiner is Mapedit. Mapedit is a WYSIWYG (What You See Is What You Get) editor for imagemap files. Mapedit teaches receiving a pre-existing image in GIF, JPEG or PNG format (Figure 9, paragraph 4) and loading the image into a scrollable, resizeable window. A user can create an image map using the image by manually drawing polygons or circles on top of the image and specifying a URL for each (Figure 8, paragraph 4). While the image can be the result of compositing several image layers together and exporting the composited image to the GIF,

Applicant : Jeffrey H. Michaud, et al.
Serial No. : 09/058,496
Filed : April 10, 1998
Page : 3 of 7

Attorney's Docket No.: 07844-273001 / P247

JPEG or PNG format, once the image is in the GIF, JPEG or PNG format, any such original layer information is lost.

The Examiner seems to assert that an image map created using Mapedit constitutes an electronic artwork having a plurality of layers, wherein each hotspot defined by the image map constitutes a layer. In particular, the Examiner states that Mapedit "teaches the saving of edited overlapping layered image regions, providing the claimed equivalent of a layered graphics file", referring to Figs. 17-19 of Mapedit (Office Action, p. 3). Mapedit shows selecting an existing image and drawing a polygonal hotspot on the image (Figs. 9 and 10). The Examiner seems to suggest that a hotspot defined in a Mapedit image map constitutes a layer.

The applicant respectfully submits there is no support in the Mapedit materials relied on by the Examiner for the assertion that an image map created using Mapedit is an "electronic artwork having a plurality of layers". Mapedit fails to disclose saving the user's polygon information defining a hotspot as a layer. The mere fact that Mapedit allows a user to draw polygons that overlap, and then provides a rule that an action associated with the first drawn polygon prevails over an action associated with a later drawn polygon, to avoid a conflict between two different actions associated with the same area (Fig. 12), does not disclose or suggest that multiple layers are being stored. Further, there is nothing inherent in the concept of an image map that suggests an image map is formed from multiple layers.

"in response to the input selecting a layer, identifying one or more regions in the selected layer as non-transparent regions in a transparent frame;

defining an area in the selected layer based on a perimeter boundary of the one or more non-transparent regions in the selected layer;"

The Examiner relies on a combination of Mapedit and White for disclosing the above limitations recited in applicant's claim 1. With respect to "defining an area in the selected area based on a perimeter boundary", the Examiner refers to Mapedit in view of White. The Examiner states that Mapedit "teaches a non-transparent region defining a hot spot region" and "White teaches automatic rescaling of an image map area subsequent to resizing of a Web page to fit different display areas" (Office Action, p. 4). The Examiner suggests that it would have

Applicant : Jeffrey H. Michaud, et al.
Serial No. : 09/058,496
Filed : April 10, 1998
Page : 4 of 7

Attorney's Docket No.: 07844-273001 / P247

been obvious to combine White's scaling with Mapedit to "create image maps for different presentation mediums by automatically defining image map boundaries subsequent to changes in size of an image map". The applicant respectfully submits the Examiner has misconstrued applicant's claim 1, and that the hypothetical method described by the Examiner fails to disclose the above limitations of claim 1. The applicant's claim 1 recites a method whereby a user selects a layer in response to which input, one or more regions in the selected layer are identified as non-transparent regions in the selected layer. An area in the selected layer is defined based on a perimeter boundary of the one or more non-transparent regions in the selected layer.

By contrast, the Examiner's hypothetical system seems to require starting with an imagemap. The imagemap is resized, apparently according to the method described in White. White describes rescaling the image size of Web page elements to fit within the dimensions of a display. A scaling factor is determined based on the dimensions of the display, and rescaled X and Y coordinates are determined.

Accordingly, the method described by the Examiner seems to operate as follows. A user selects a hotspot from an existing image map already created with Mapedit, a hotspot being a hotspot layer. Assuming the hotspot is a non-transparent region (which the applicant does not concede), then the non-transparent region in the hotspot layer before resizing will be referred to as a first non-transparent region. Per White, input concerning the dimensions of a display must be received and a scaling factor then determined. The X and Y coordinates of the perimeter boundary of the first non-transparent region are then rescaled according to the scaling factor. A modified perimeter boundary can then be defined based on the rescaled X and Y coordinates. A key distinction here is in how the area is defined. In the Examiner's method, an area is defined by a modified perimeter boundary, which modified perimeter boundary is determined by a rescaling operation.

By contrast, claim 1 recites defining an area in the selected layer based on a perimeter boundary of the one or more non-transparent regions in the selected layer, i.e., a perimeter boundary of a non-transparent region as it existed in the layer when the layer was selected by the user. The area is defined based on a perimeter boundary of a non-transparent region. This is

Applicant : Jeffrey H. Michaud, et al.
Serial No. : 09/058,496
Filed : April 10, 1998
Page : 5 of 7

Attorney's Docket No.: 07844-273001 / P247

different from the Examiner's system, which modifies a perimeter boundary by rescaling, which modified perimeter boundary then encloses a non-transparent region and defines an area.

Further, the defining of an area in the selected layer based on the perimeter boundary of the non-transparent region recited in claim 1 is in response to the user input selecting the area, and not in response to a resizing operation.

Accordingly, the Examiner's hypothetical system, which the applicant does not concede is even disclosed or suggested by the references, does not disclose or suggest the above limitations recited in claim 1.

Because at least these elements of the applicant's claimed invention are not disclosed or suggested by either Mapedit or White, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established. Claim 5 is an analogous computer product claim to claim 1. Claims 2-4, 12-13, 29 and 35-36 depend directly or indirectly from claim 1 and claims 7-9, 20-22, 30 and 42-43 depend directly or indirectly from claim 5. Accordingly, for at least the aforementioned reasons, claims 1-5, 7-9, 12-13, 20-22, 29-30, 35-36 and 42-43 are allowable.

Claims 15-16 and 24-25

Claims 15-16 and 24-25 are also rejected under U.S.C. 103(a) as being unpatentable over Mapedit in view of White and U.S. Patent No. 5,991,781 ("Nielsen").

Claim 15 recites a method that depends from claim 1. The claim further defines the selected layer as having two or more non-contiguous non-transparent regions in a transparent frame and recites that the area is defined based on a perimeter boundary of the non-transparent regions in combination. That is, the hotspot includes the non-contiguous non-transparent regions in combination. Claim 16 recites a method that further comprises a step of generating multiple image maps from the non-transparent regions. Claims 24 and 25 are analogous computer program claims.

The applicant respectfully submits the Examiner has misconstrued Nielsen as disclosing the elements of claim 15. Nielsen discloses having more than one contiguous region and having a different action associated with each contiguous region.

Applicant : Jeffrey H. Michaud, et al.
Serial No. : 09/058,496
Filed : April 10, 1998
Page : 6 of 7

Attorney's Docket No.: 07844-273001 / P247

Mapedit, White and Nielson fail to disclose the elements of claim 15, and a *prima facie* case of obviousness has not been established. Claim 16 depends from claim 15 and claims 24-25 are analogous computer program claims to claims 15 and 16 and are similarly allowable for at least the above reasons.

Claims 6, 28, 31-34 and 38-41

Claims 6, 28, 31-34, 38-41 are also rejected under U.S.C. 103(a) as being unpatentable over Mapedit in view of White and U.S. Patent No. 5,956,701 ("Habermehl"). The applicant respectfully traverses the rejections and requests reconsideration in view of the amendments and following remarks.

Claim 6 recites a computer program claim, dependent on claim 5, that further comprises instructions to automatically fit a shape to the perimeter boundary, wherein the shape defines the area. Claim 28 is an analogous method claim.

Habermehl describes a method where "the user defines the specified region by selecting points within the region by performing an act such as randomly clicking an input device such as a mouse, associated with a cursor, within the specified region" (col. 3, lines 22-25). Habermehl does not teach automatically fitting a shape to the perimeter boundary. Habermehl requires the user to click at least three times to define an area within the region (col. 3, lines 25-29). "[A] boundary which is more complex will require a larger number of clicks than a boundary which is relatively simple" (col. 3, lines 34-36). The Examiner fails to explain how Habermehl discloses automatically fitting a shape to a perimeter boundary.

The applicant submits Mapedit, White and Habermehl fail to disclose the elements of claim 6, and no *prima facie* case of obviousness has been made. Claims 31-34 depend from claim 28, claims 38-41 depend from claim 6. For at least the reasons stated above, these claims are similarly allowable.

Allowable Subject Matter

Claims 37 and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

Applicant : Jeffrey H. Michaud, et al.
Serial No. : 09/058,496
Filed : April 10, 1998
Page : 7 of 7

Attorney's Docket No.: 07844-273001 / P247

claim and any intervening claims. In view of the above remarks, the applicant respectfully submits claims 37 and 44 are in condition for allowance.

No fees are believed due, however, please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date:

Oct 23, 2003

Jennifer A. Zappo
Jennifer A. Zappo
Reg. No. 54,563

Fish & Richardson P.C.
500 Arguello Street, Suite 500
Redwood City, California 94063
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50167208.doc

**RECEIVED
CENTRAL FAX CENTER**

OCT 23 2003

OFFICIAL